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EXAMINER

IP, SIKYIN

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Objections

Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 20 fails to further limit the subject matter of a previous claim 19 which has been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5, 6, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5389160 to Melton et al in view of JP 57152438.

Melton discloses the features including the claimed Sn-Bi-Ag solder and flux (col. 2, lines 30-55 and col. 1, lines 57-61). Melton further teaches to add up to 4 wt.% alloy agents to enhance mechanical properties (col. 3, lines 43-46). Melton does not disclose the alloy agent is Fe-Ni (Invar alloy). However, JP 57152438 discloses Fe-Ni alloys would enhance thermal expansion property (see abstract) in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide solder of Melton with Fe-Ni as taught by JP 57152438 because the set forth benefits and function entail the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. Flux wets the solder composition, which is merely the function of the flux. According to the specification (paragraph bridging pages 6-7), the wording "pretreated" reads on "mixing".

Claims 3 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5389160 to Melton et al in view of JP 57152438 as applied to claims above, and further in view of Beal (PTO-1449).

Melton et al in view of JP 57152438 disclose the features substantially as claimed as set forth in the rejection above except for the flux ingredients. However, Beal discloses claimed inorganic fluxes are known in the same field of endeavor or the analogous metallurgical art of cited references (see page 434, low-right col). Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide Melton with fluxes as taught by Beal in order to improve/provide surface condition (See Beal, page 434 "Fluxes").

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5, 6, 16-18, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-6 of copending Application No. 10/744326. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because claimed solder compositions and additives are overlapped.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed May 9, 2007 have been fully considered but they are not persuasive.

Applicants' statement in paragraph bridging pages 8-9 of instant remarks and page 6, line 21 to page 7, line 2 of the specification as originally filed is noted. The wording "pretreating" according to said pages in instant specification merely means mixing the additives with flux.

Applicants' argument with respect to Beal is noted. But Beal is merely cited to show claimed fluxes are known common fluxes in soldering art.

Applicants' argument with respect to JP 57152438 is noted. But, claimed "granular" additive is not excluding powder as taught by said reference. Moreover, applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' argument in page 10, third paragraph of instant remarks is noted. Applicants' attention is directed to rejections above and pasted here for applicants' convenience that Melton discloses Sn-Bi-Ag solder and flux (col. 2, lines 30-55 and col.

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1, lines 57-61). Melton further teaches to add up to 4 wt.% alloy agents to enhance mechanical properties (col. 3, lines 43-46). JP 57152438 discloses Fe-Ni alloys would enhance thermal expansion property (see abstract). Beal discloses claimed inorganic fluxes are known in the same field of endeavor or the analogous metallurgical art of cited references (see page 434, low-right col).

Applicants' argument directs to page 429 of Beal is noted. But, those impurities are directed to leaded solders. Nonetheless, alloying elements can be added/removed for desired properties in alloying art. It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
July 20, 2007